

Amendments to the Drawings:

The drawing sheets attached in connection with the above-identified application containing Figures 1-3 are being presented as sheets to be substituted for the previously submitted drawing sheets. Figures 1 and 2 have been amended. Appended to this amendment is an annotated copy which has been marked to show changes presented in the replacement sheet of the drawing.

The specific change which has been made to Figure 1 is the addition of roller coating unit (16).

The specific changes which have been made to Figure 2 is the addition of a device 15 for cleaning the carrier plates, removing reference numeral 7 and its corresponding leader line, rotating the wires 7 so that they are orientated in the correct direction, and moving reference numeral 3 and its corresponding leader line into its correct position.

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1-13 have been amended. Claims 14-17 have been added. No claims have been canceled.

Applicant wishes to thank the Examiner for the careful consideration given to the claims as well as indicating that claim 13 contains allowable subject matter.

The Information Disclosure Statement (IDS)

The PTO indicated that it did not consider a particular reference in the IDS submitted on 2/26/2004, particularly EP 0-450-482, by asserting that there was no concise explanation of relevance. Applicant respectfully disagrees because the IDS was submitted with a statement that the reference in question was cited in the search report of the corresponding European application, which satisfies this requirement for a concise explanation of the relevance. Applicant respectfully requests that the Examiner consider the reference and send a copy of the initialed IDS to Applicant.

The Drawing Objections

The PTO has objected to Figure 2 by asserting that the reference numeral "3" has been used to designate both the "carrier plate" and the "cross drive." Applicant has amended Figure 2 by moving the reference numeral 3 and its leader line.

The PTO has also objected to the Figures because they do not show every feature of the invention specified in the claims, particularly claims 6, 8, and 11. Claim 6 includes "a device for cleaning" while claim 8 includes "a cleaning device." Figure 2 has been amended to include the device for cleaning 15 as described in paragraph 0025 of the specification, which would have been readily understood by one skilled in the art. In addition, claim 11 includes "a roller coating unit." Figure 1 has been amended to include the roller coating unit 16 as described in paragraph 0030 of the specification, which would have been readily understood by one skilled in the art.

It is noted that Figure 2 has been amended because wires 7 were erroneously rotated in the wrong direction. As clearly indicated in the written description, Figure 2 is viewed along

section line A-A in Figure 1. Thus, the wires 7 in Figure 2 should be viewed along their longitudinal direction and not along their ends.

In view of the amendments to Figures 1 and 2, reconsideration and withdrawal of the objection is respectfully requested.

Specification

The PTO noted that the trademark “Teflon” and “Talcum powder” were used in the specification. It is not stated whether the specification is objected to or not. Regardless, Applicant has amended the specification such that “Teflon” was changed to “TEFLON®” throughout the specification. As to “Talcum powder,” it is respectfully submitted that Talcum powder is not a trademark but merely a powder made from talc. Therefore, it is submitted that no change to “Talcum powder” is required.

Rejection of Claims 6, 8, and 11 under 35 U.S.C. § 112, first paragraph.

The PTO has rejected claims 6, 8, and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the PTO asserts that because the specification does not show in the Figures or describe in the written description the cleaning device or roller coating unit, one with ordinary skill in the art would not be enabled to practice the invention. Applicant respectfully disagrees.

As to the cleaning devices, the use of such devices would be well understood by one with ordinary skill in the art. Such devices would be understood to encompass scrapping devices, brushes, air blowing device, etc. For example, the specification mentions that cleaning can be performed in which plastic residues become stripped away by a divided stroke. (Paragraph 0016 of the specification.) One with ordinary skill in the art would readily understand this passage to include using a wiping device, such as a brush or sleeve, to stroke off the plastic residue from the resilient plates.

As to the use of a roller coating unit, this unit would also be understood by one with ordinary skill in the art from its name alone. A roller coating unit would encompass a device used to apply a coating to a surface using a rolling applicator.

For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of Claims 1-13 under 35 U.S.C. § 112, second paragraph.

The PTO has rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended the claims to address the examiner's comments. In addition, Applicant makes the following comments.

The PTO asserts that "resilient" in claim 1 is a relative term which renders the claim indefinite. Applicant respectfully disagrees because the term "resilient carrier plates" is sufficiently definite in light of the functional explanation of its use in the specification. For example, the specification states that the carrier plates can pick up a plastic product, can be slipped beneath the plastic product, and can leave no or only very little marks on the plastic's finished molding. In light of these functional considerations, one with ordinary skill in the art would be able to ascertain the meaning of "resilient carrier plates" and which devices constitute such resilient carrier plates. Because the meaning of "resilient carrier plates" can be readily ascertained by one with ordinary skill in the art, the term does not render claim 1 or any of the other claims indefinite.

Next, the PTO states that it is unclear what is meant by "spring steel." To aid in the examination of the application, Applicant has attached a copy of page 2211 of Webster's Third New International Dictionary, 1976 as Exhibit A. The definition in this dictionary states that spring steel is "a steel that is processed (as by cold drawing, cold rolling, or heat treating) to give it the elastic properties and yield strength useful in springs." In addition, a search of the term "spring steel" in the PTO's database shows that the term is used in about 17976 patents and about 4370 patent applications publications. Thus, the term "spring steel" is a term that is readily recognizable in the art and one with ordinary skill in the art would be able to understand its meaning and scope. Because the meaning and scope of the term can be ascertained by one with ordinary skill in the art, "spring steel" does not render claim 3 indefinite.

As to claim 11, the PTO states that "a bottom stretch" is unclear and it was interpreted to mean any part of the conveyer belt. Although Applicant believes that "a bottom stretch" is

sufficiently clear, Applicant has amended claim 11 so that “a bottom stretch” was changed to “bottom return run.” As is well known in the art, a conveyor belt typically carries items on a carrying portion in one direction then loops down underneath the carrying portion to return to the starting point of the carrying portion, as seen in Figure 1 of the present specification. The “bottom return run” refers to the portion that runs beneath the carrying portion and returns to the starting point of the carrying portion.

Rejection of claims 1-2 and 4-5 as being unpatentable over Yamazaki in view of Mueller.

The PTO has rejected claims 1-2 and 4-5 as being unpatentable over U.S. Patent 6,074,163 (“Yamazaki”) in view of U.S. Patent 6209,710 (“Mueller”). For at least the following reasons, this rejection is traversed.

Claim 1 comprises a method for picking up a plastic product by one or more resilient carrier plates. Claim 2 comprises an apparatus for picking up a tacky plastic product that comprises resilient carrier plates. Yamazaki, Mueller, or any combination thereof does not teach or suggest these features.

The MPEP 2143 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations....The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The PTO has failed to satisfy the first and third criteria for establishing a *prima facie* case of obviousness. As to the first criteria, there is no motivation or suggestion to combine the teachings with Yamazaki and Mueller as suggested by the PTO. First, there is no teaching in the prior art that would motivate one to combine the teachings of Yamazaki and Mueller. In addition, Yamazaki teaches a system for picking up glass plates at their bottom surface while Mueller teaches a system for picking up plastic bottles by their neck. These are two

entirely different types of systems used to pick up entirely different products. One with ordinary skill in the art would not be motivated to combine these two systems since they deal with entirely different methods for picking up very differently shaped products. Because one would not have been motivated to combine these two very different systems, the combination of the teachings of Yamazaki and Mueller is improper.

As to the third criteria, Yamazaki teaches the use of a device that picks up glass plates using arms made from a wear resistant material but it says nothing about the material being resilient. Mueller does not cure this deficiency. Thus, any combination of Yamazaki and Mueller does not meet all the claim limitations of claims 1 or 2.

Because there is no motivation to combine and the combined teachings of Yamazaki and Muller do not teach resilient carrier plates, claims 1-2 are not rendered unpatentable over the prior art.

Dependent claims 4-5 are also not rendered unpatentable for at least the same reasons as claim 2 from which they depend.

For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 6 and 8 as being unpatentable over Yamazaki in view of Mueller and Cohen.

The PTO has rejected claims 6 and 8 as being unpatentable over Yamazaki in view of Mueller and U.S. Patent 6,332,636 ("Cohen"). For at least the following reasons, this rejection is traversed. Claims 6 and 8 depend from and include all the limitations of claim 2. As previously mentioned, the teachings of Yamazaki and Mueller do not teach resilient carrier plates and the motivation to combine these two references is improper. Cohen does not cure these deficiencies. Thus, claims 6 and 8 cannot be rendered unpatentable over the prior art. For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claim 3 as being unpatentable over Yamazaki in view of Mueller and Focke.

The PTO has rejected claim 3 as being unpatentable over Yamazaki in view of Mueller and U.S. Patent 5,417,543 (“Focke”). For at least the following reasons, this rejection is traversed. Claim 3 requires that the resilient carrier plates are made from spring steel. As previously mentioned, the motivation to combine the teachings of Yamazaki and Mueller is improper.

In addition, there is no motivation to combine the teachings of Focke to the combined teachings of Yamazaki and Mueller. The PTO asserts that it would have been obvious to use a resilient flexible spring steel material as taught by Focke “for the purpose of using a metal which is elastically deformable like leaf springs.” This is not a proper motivation because, essentially, the argument is saying that it would have been obvious to use spring steel material because one has the purpose to use spring steel material. This is circular reasoning and contrary to case law and the MPEP, which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” (MPEP 2143.) There has been no suggestion to make the claimed combination in the art. In fact, the PTO improperly used Applicant's disclosure as a blue print to form the claimed combination. Thus, this is an improper rejection because there is no motivation to combine the teachings to Yamazaki, Mueller, and Focke.

For at least this reason, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claim 7 as being unpatentable over Yamazaki in view of Mueller and McGill.

The PTO has rejected claim 7 as being unpatentable over Yamazaki in view of Mueller and U.S. Patent 4,183,428 (“McGill”). For at least the following reasons, this rejection is traversed. Claim 7 depends from and include all the limitations of claim 2. As previously mentioned, the teachings of Yamazaki and Mueller do not teach resilient carrier plates and the motivation to combine these two references is improper. McGill does not cure

these deficiencies. Thus, claim 7 cannot be rendered unpatentable over the prior art. For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 9-12 as being unpatentable over Yamazaki in view of Mueller and Dischler.

The PTO has rejected claims 9-12 as being unpatentable over Yamazaki in view of Mueller and U.S. Patent 6,279,211 ("Dischler"). For at least the following reasons, this rejection is traversed. Claims 9-12 depend from and include all the limitations of either claim 1 or claim 2. As previously mentioned, the teachings of Yamazaki and Mueller do not teach resilient carrier plates and the motivation to combine these two references is improper. Dischler does not cure these deficiencies. Thus, claims 9-12 cannot be rendered unpatentable over the prior art. For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By George E. Quillin

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5413
Facsimile: (202) 672-5399

George E. Quillin
Attorney for Applicant
Registration No. 32,792